APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/394,143	09/10/1999	PAUL CHARLES TURGEON	044624-15-NP	3795

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EXAMINER
HEWITT II, CALVIN L

ART UNIT	PAPER NUMBER
3621	

DATE MAILED: 08/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>27 March 2006</u>.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-25</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-25</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

Status of Claims

1.   Claims 1-25 have been examined.

Response to Amendment/Argument

2.   The Examiner is applying new 112 rejections. Applicant's claim 1 is directed to a structure. Specifically, a system comprising a network access device and a decryption processor. Claim 1 also recites how said structure is used. For example, the claim includes the language of, "said each *customer using* said network access device and a computer readable portable storage medium *to access* said each customer's financial account via said public network" (emphasis added). The claim also recites the method step of providing a network access device "for each customer" and the user accessing a financial account stored at a financial institution over a public network. Although the claim does not specifically recite "providing", this is a fair reading as a customer does not and cannot limit the structure of the network access device. Therefore, the scope of claim 1 is unclear (*IPXL Holdings LLC v. Amazon.com Inc.,* 77 USPQ2d 1140 (CA FC 2005)). Similarly, claims 2 (*using said computer readable portable medium*), 3 (said *network device...* said unencrypted information is *provided to said customer who is requested* to enter...), and 13

(wherein said CD-ROM *is produced* by a card production facility) (emphasis

added) are also rejected under 112. Claim 1 also recites a computer readable

medium that stores unencrypted and encrypted information. It has been held that

when descriptive material is not functionally related to the substrate, the

descriptive material will not distinguish the invention from the prior art in terms of

patentability. In other words, non-functional data as descriptive material cannot

render nonobvious an invention that would have otherwise been obvious (*In re

Gulack*, 217 USPQ 401 (Fed. Cir. 1983)). The unencrypted data of the claim 1

portable medium is nonfunctional as it does not alter how the claim 1 system

functions (MPEP 2106 section V, B, 2). Similarly, the identifiers and the *type* of

unencrypted information of claims 14-16 and 20-22 are also nonfunctional data.

Some of Applicant's claimed system features are expressed as functional

language and intended use (e.g. claims 1, 2, 4, and 5). For example, the claims

recite "a programm*able* controller for executing code and a memory *for* storing

browser software *to interface*", a decryption processor "*for* decrypting said

encrypted information retrieved from said storage medium *such that...*", "a

microprocessor *operative to*", and "*generates* a code" (emphasis added). It has

been held that while features of an apparatus maybe recited structurally or

functionally, claims directed to an apparatus must be distinguished in terms of

structure alone (MPEP 2114 and *Ex parte Masham*, 2 USPQ2d 1647 (1987); *In*

re *Swineheart*, 169 USPQ 226; *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir.

1997)).

Claim Rejections - 35 USC § 112

3.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4.   Claims 1-25 are rejected under 35 U.S.C. 112, second paragraph, as

being indefinite for failing to particularly point out and distinctly claim the subject

matter which applicant regards as the invention.

Applicant's claim 1 is directed to a structure. Specifically, a system

comprising a network access device and a decryption processor. Claim 1 also

recites how said structure is used. For example, the claim includes the language

of, "said each *customer using* said network access device and a computer

readable portable storage medium *to access* said each customer's financial

account via said public network" (emphasis added). The claim also recites the

method step of providing a network access device "for each customer" and the

user accessing a financial account stored at a financial institution over a public

network. Although the claim does not specifically recite "providing", this is a fair

reading as a customer does not and cannot limit the structure of the network

access device. Therefore, the scope of claim 1 is unclear (*IPXL Holdings LLC v.*

Amazon.com Inc., 77 USPQ2d 1140 (CA FC 2005)). Similarly, claims 2 (*using*

said computer readable portable medium), 3 (said *network device...* said

unencrypted information is *provided to said customer who is requested* to

enter...), and 13 (wherein said CD-ROM *is produced* by a card production

facility) (emphasis added) are also rejected as it is unclear whether the claims

are directed to a process or apparatus.

Claims 2-16 are also rejected as each depends from either claims 1, 2, 3,

or 13.

Claim 3 recites "wherein said active module contains code which executed

by said programmable controller in said network access device...". Claim 2, from

which claim 2 depends, recites "said computer comprising a microprocessor

being *operative to transfer* an active module" (emphasis added). Therefore, claim

3 is indefinite as it is unclear whether or not the active module was actually sent

by the microprocessor of claim 2 (*In re Collier,* 158 USPQ 266 (CCPA 1968);

MPEP 2100-8, first column). Similarly, claims 4 and 5 are also rejected.

Claim 17 recites "decrypting the retrieved encrypted information such that

the financial institution maintaining said each customer's financial account

determines an access to said each customer's financial account". However, this

is unclear as the financial institution never receives the decrypted information.

Claims 18-25 are also rejected as each depends from claim 17.

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for

all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set
forth in section 102 of this title, if the differences between the subject matter sought to be patented and
the prior art are such that the subject matter as a whole would have been obvious at the time the
invention was made to a person having ordinary skill in the art to which said subject matter pertains.
Patentability shall not be negatived by the manner in which the invention was made.

6.   Claims 1, 12-17, and 23-25 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Chen et al., U.S. Patent No. 5,590,197 in view of Krishnan et

al., U.S. Patent No. 6,073,124.

            As per claims 1, 12-17, and 23-25, Chen et al. teach a system for

providing financial services over a public network accessible by a plurality of

customers via respective network access devices with modems (e.g. personal

computers) and over a private network accessible by a plurality of financial

institutions via computers with modems, said financial institutions maintaining

respective financial accounts for said plurality of customers, at least some of said

financial accounts being maintained at different ones of said financial institutions

(figure 1; column 6, lines 28-31) comprising:

- a network access device with browser software (figure 1; column 4,

  lines 46-50)

- a customer with a computer readable portable storage medium

  (column/line 4/63-5/11; column 6, lines 12-27) that stores locked

  (column 5, lines 5-11; column 6, lines 38-43) and unencrypted

information (e.g. browser) (abstract; column 4, lines 4-6; column 6,

lines 12-17)

- a decryption processor connected to said access device for

  decrypting encrypted information stored on the portable medium

  and determining access to a user financial account using the

  decrypted information (column 6, lines 48-58)

Regarding encrypted information, Chen et al. teach digital wallets, storing wallet

information on a portable memory (abstract) and encrypting wallet information

More specifically, Chen et al. disclose producing the storage medium by storing

unencrypted and locked information on the medium (column 6, lines 12-23;

column 6, lines 38-44). However, Chen et al. do not explicitly recite "locking"

such as encrypting. And although Chen et al. teach encrypting wallet information,

the reference does not explicitly recite when the wallet account information is

encrypted. Krishnan et al. teach wallets that encrypt credit card data and store

the encrypted data on a computer readable medium (column 21, lines 2-8). As

per claim 25, if the transaction is denied, an address is not displayed to a user

(MPEP section 2106, II, C). Therefore, it would have been obvious to one of

ordinary skill to store the wallet data in encrypted form in order to more efficiently

process a transaction as public key encryption is computationally intensive.

7.   Claims 2-11 and 18-22 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Chen et al., U.S. Patent No. 5,590,197 in view of Linehan,

U.S. Patent No. 6,327,578.

            As per claim 2, Chen et al. teach a computer for hosting a site for goods

and services connected to a network access device (figure 1). However, Chen et

al. do not explicitly recite the computer sending an active module to the network

access device in response to a customer requesting access to said customer's

financial account. Linehan teaches the computer sending an active module to the

network access device in response to a customer requesting access to said

customer's financial account (column/line 5/53-6/3). Therefore, it would have

been obvious to one of ordinary skill to combine the teachings of Chen et al. and

Linehan in order to allow issuing banks to use a preferred authentication method

('578, column 9, lines 3-13) such an account number and PIN ('578, column 12,

lines 28-30; '197, column 6, lines 12-18) and reduce overhead for merchant and

payment gateway ('578, column 9, lines 13-18).

            As per claims 3, 4, 18 and 19, Chen et al. teach a customer with a

computer readable portable storage medium (column/line 4/63-5/11; column 6,

lines 12-27) that stores encrypted (column 6, lines 38-43) and unencrypted

information (e.g. browser) (abstract; column 4, lines 4-6; column 6, lines 12-17).

Chen et al. also teach encrypting said wallet information with a credit card

specific key (column 4, lines 6-14). It is also well known for digital wallets to

encrypt wallet (e.g. credit card) data stored on a computer readable medium.

Chen et al. teach providing unencrypted information (e.g. browser) for carrying

out a financial transaction (column 4, lines 1-8; column 6, lines 27-32). Chen et

al. do not specifically entering a first identifier. Linehan teaches entering a first

identifier into a browser (column 9, lines 40-46). Linehan also teaches sending

the identifier over a network along with encrypted wallet information and

decrypting the wallet information (e.g. SSL) (column 2, lines 62-65; column 4,

lines 65-67; column/line 5/65-6/3; column 7, lines 3-5 and 38-54). Therefore, it

would have been obvious to one of require a user to enter authentication ID such

as a PIN in order to verify the identity of the user who desires to access a

financial account for providing payment to a merchant ('578, column 1, lines 32-

38; column 12, lines 23-30).

As per claims 5-7, the primary reference of Chen et al. teach passing on

encrypted account information to a financial institution for deciding whether or not

to authorize a transaction (column 6, lines 47-57). This is also taught by Linehan.

More specifically, Linehan teaches the financial institution receiving card or

account number and determining whether the transaction should be authorized

(as an aside, the institution replaces the card number with a "reference" and

forwards the reference to the gateway indicating authorization) (figure 8, item

808; column 9, lines 52-53). The gateway and the institution communicate across

a private network. Private networks implemented by encrypting communications

between a first computer and a second computer are old and well known,

therefore, the gateway decrypts the communication from the consumer (e.g.

SSL) to reveal the card or account number (figure 8, item 804; column 12, lines

22-30) and re-encrypts the card or account number using the private network key

for transmission to the financial institution via the private network (figure 2A).

Linehan also teaches the institution generating an approval code and sending the

code to the decryption processor over a network (private to public) switch (figure

2B; figure 7). Therefore, it would have been obvious to one of ordinary skill to

combine the teachings of Chen et al. and Linehan in order to allow issuing banks

to use a preferred authentication method ('578, column 9, lines 3-13) such an

account number and PIN ('578, column 12, lines 28-30; '197, column 6, lines 12-

18) and reduce overhead for merchant and payment gateway ('578, column 9,

lines 13-18).

As per claim 8, if the transaction is denied, an address is not displayed to

a user (MPEP section 2106, II, C).

As per claims 9-11 and 20-22, it has been held that when descriptive

material is not functionally related to the substrate, the descriptive material will

not distinguish the invention from the prior art in terms of patentability. In other

words, non-functional data as descriptive material cannot render nonobvious an

invention that would have otherwise been obvious (*In re Gulack*, 217 USPQ 401

(Fed. Cir. 1983)). Chen et al. teach providing unencrypted information (e.g.

browser) for carrying out a financial transaction (column 4, lines 1-8; column 6,

lines 27-32). Therefore, non-functional data such as the type of unencrypted data

presented to a user will not differentiate the claims from the prior art as the type

of unencrypted information does not alter how the claimed system functions

(MPEP 2106 section V, B, 2).

8.   Claims 12-16 and 23-25 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Chen et al., U.S. Patent No. 5,590,197 and Krishnan et al.,

U.S. Patent No. 6,073,124, as applied to claims 12 and 17 above, and in further

view of Diezmann et al., U.S. Patent No. 6,044,046.

Chen et al. teach storing locked wallet information and unencrypted

information on programmable memory such as PCMCIA cards, PDAs or the like

(abstract). Krishnan et al. teach locking wallet information by encrypting the

information and storing the encrypted wallet on programmable memory (column

21, lines 2-8). However, neither Chen et al., nor Krishnan et al. explicitly recite

CD-ROMs. Diezmann et al. (abstract) disclose CD-ROMs that comprise a

processor. Therefore, it would have been obvious to one of ordinary skill to use

whatever (*In re Wolfe*, 116 USPQ 443, 444 (CCPA 1961)) programmable

memory that best meets the needs of the user or the account servicer ('197,

column 6, lines 12-26).

Conclusion

9.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure:

- Rasmussen et al. disclose private networks

10.   Any inquiry concerning this communication or earlier communications from

the Examiner should be directed to Calvin Loyd Hewitt II whose telephone

number is (571) 272-6709. The Examiner can normally be reached on Monday-

Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the

Examiner's supervisor, James P. Trammell, can be reached at (571) 272-6712.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

c/o Technology Center 3600

Washington, D.C. 20231

or faxed to:

(571) 273-8300 (for formal communications intended for entry and
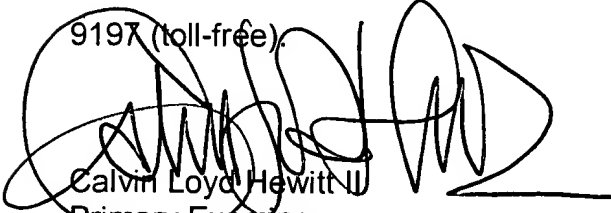
after-final communications),

or:

(571) 273-6709 (for informal or draft communications, please label

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9197 (toll-free).

Calvin Loyd Hewitt
Primary Examiner

July 24, 2006

WYNN W. COGGINS
TECHNOLOGY CENTER DIRECTOR